<u>REMARKS</u>

The above Amendments and these Remarks are in reply to the Office Action mailed November 17, 2003.

Currently, claims 1-19 are pending. Applicants have amended claims 1, 4, 5, and 12 and added claim 19. Applicants respectfully request reconsideration of claims 1-18 and consideration of claim 19.

I.   **Summary of Office Action**

Claims 5 and 12 were rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 5,804,803 A ("*Cragun*").

Claims 1-4, 6-11, and 13-18 were rejected under 35 USC 103(a) as being unpatentable over *Cragun* in view of U.S. Patent No. 5,1131,398 ("*Nunberg*").

II.   **Summary of Amendments to the Claims**

Claims 1, 4, 5, and 12 have been amended.

Claim 19 has been added.

No new matter has been added.

III.   **Summary of Amendments to the Specification**

The Specification has been amended to recite that the present application: "is a continuation-in-part of U.S. Patent Application entitled TRANSFERRING E-MAIL ATTACHMENTS TO DEVICES FOR RENDERING, U.S. Application No. 09/652,761, filed on August 31, 2000, now U.S. Patent No. 6,360,252, which claims the benefit of U.S. Provisional Patent Application No. 60/155,024, filed on September 20, 1999, entitled METHOD AND APPARATUS FOR PROVIDING MOBILE ACCESS TO COMPUTER NETWORKS; and

claims the benefit of U.S. Provisional Patent Application No. 60/155,024, filed on September 20, 1999, entitled METHOD AND APPARATUS FOR PROVIDING MOBILE ACCESS TO COMPUTER NETWORKS, the contents of which are hereby incorporated by reference in their entirety."

The present application was filed before November 29, 2000.

No new matter has been added by the amendment.

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IV.   Rejection of Claims 5 and 12 under 35 U.S.C. 102(e) over *Cragun*

Claims 5 and 12 were rejected under 35 USC § 102(e) as being anticipated by U.S. Patent No. 5,804,803 A ("*Cragun*"). It is respectfully submitted that amended claims 5 and 12 are novel and patentable over *Cragun* under § 102(e) because *Cragun* fails to disclose every limitation of claims 5 and 12.

It is respectfully submitted that *Cragun* fails to disclose:

> receiving, at the server machine, a request to perform a server action including at least one of an email operation, a chat operation, and a calendar operation; ... and
> performing said server action including incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation,

as recited in claims 5 and 12.

Cragun teaches a specialized "mechanism for retrieving information using data encoded on an object." *Cragun*, title. *Cragun* is directed exclusively to an abbreviated URL (uniform resource locator) translated from code scanned from an object and expanding the abbreviated URL to specify "both a server computer and the location within the server of information that is relevant to the object." *Cragun*, abstract. The processing program of *Cragun* "uses scanning device 118 to scan code 117 from object 115." *Id.* at col. 8, ll. 18-21. From the code itself or a database accessed using the UPC as an identifier, a "(URL) string" is obtained. *Id.* at col. 8, ll. 21-35 (emphasis added). If the URL is an abbreviated URL, "processing program 110 expands the URL to expanded form." *Id.* at ll. 34-39. "Processing program 110 fills in any embedded query fields to create datafilled form 240." *Id.* at ll. 42-45. The completed URL is sent to an external network so that the "document 174 requested by the completed URL returns to client computer 102 from remote server 160." *Id.* at ll. 46-54. Thus, the URL is expanded and used like a command or instruction to a server computer to retrieve a document from a specified location.

Cragun teaches nothing beyond abbreviated URL's that are used to retrieve documentation for an object. There is no mention, teaching or suggestion of anything relating to server actions including "at least one of an email operation, a chat operation, and a calendar operation," as recited in claims 5 and 12. In *Cragun*, a URL is expanded and used as an

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instruction or command for a server to retrieve a particular document. There is no disclosure relating to "incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation," as recited in claims 5 and 12. In *Cragun*, the expanded URL is used as an instruction to retrieve a document and is not incorporated into any sort of display data.

Accordingly, *Cragun* fails to disclose "receiving, at the server machine, a request to perform a server action including at least one of an email operation, a chat operation, and a calendar operation," or "performing said server action including incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation."

It is further submitted that there is no teaching or suggestion to modify *Cragun* to arrive at Applicant's invention recited in these limitations of claims 5 and 12. *Cragun* deals exclusively with URL's and expanding them to retrieve documentation related to objects. Because "the standard format [of an Internet URL] is frequently too long to be of practical use for printing with a bar code," *Cragun* teaches the use of a scanning device to scan a bar code for an abbreviated URL and translate it to a complete URL. *Cragun*, col. 5, ll. 63-65. *Cragun* provides nothing to suggest altering the mechanism disclosed therein to "an email operation, a chat operation, and a calendar operation," in the context of a client device and server machine and "incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation," as recited in claims 5 and 12. *Cragun* only suggests expanding URL's to retrieve a document stored at a server. There is nothing to suggest expanding anything else for any other reason.

In *Cragun*, an expanded URL is used as an instruction to retrieve a document rather than being incorporated into display data. There is no suggestion relating to "incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation." With *Cragun's* limited disclosure relating to URL's, bar codes, and physical objects, one of ordinary skill in the art would find no motivation or suggestion for "performing said server action including incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation," as recited in claims 5 and 12.

It is further submitted that *Cragun* also fails to disclose:

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determining whether said abbreviated substring is constrained to be identically produced;

if said abbreviated substring is constrained to be identically produced, then performing said server action using said abbreviated substring without expanding said abbreviated substring;

as further recited in claims 5 and 12.

The Examiner cites "Fig. 6A, # 616; col. 6, ll. 6-9; step 616 = False, proceeds to Fig. 6B, steps 620 and 622" for the disclosure of these limitations. In decision box 616 cited by the Examiner, however, *Cragun* merely makes a determination as to "whether the URL string is in abbreviated form," not whether an "abbreviated substring is constrained to be identically produced," as recited in claims 5 and 12. *Cragun,* Fig. 6A; col. 8, ll. 31-39 (emphasis added). As Applicant describes in the Specification, some abbreviated character strings "must be identically reproduced," in some implementations. *Specification*, p. 38, ll. 7-10. These can include "user names and IDs, passwords, PINs, e-mail addresses, and so forth." *Id.* Accordingly, claims 5 and 12 recite "if said abbreviated substring is constrained to be identically produced, then performing said server action using said abbreviated substring without expanding said abbreviated substring."

Cragun makes no mention of constraining some abbreviated URL's to be identically produced. *Cragun* expands all abbreviated URL's. If the URL is abbreviated, *Cragun* expands the URL at step 618 and then proceeds to step 620. *Id.* If the URL is not abbreviated, *Cragun* proceeds directly to step 620. *Id.* *Cragun* simply teaches to expand the URL if it is abbreviated and not expand the URL it if it is not abbreviated. In *Cragun*, an abbreviated URL is always expanded, as illustrated in Fig. 6a, #616, and the accompanying description. *Cragun* makes no mention of and fails to teach an abbreviated substring that "is constrained to be identically produced" or "performing said server action using said abbreviated substring without expanding said abbreviated substring," as recited in claims 5 and 12 (emphasis added).

It would seem that not expanding an abbreviated URL would cause the mechanism of *Cragun* not to function. Thus, *Cragun* also fails to suggest modifying the mechanism described therein to arrive at Applicants' claimed invention. The URL in *Cragun* "identifies the location address (both the server name and the location within the server) of the document of interest." *Cragun*, col. 5, ll. 58-62. If the URL is not expanded, it does not seem the document could be retrieved as the "location address" would not be complete. The "server name and the location

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within the server of the document of interest" would not be identified such that they can be located to retrieve "the document of interest." *Id.* Hence, *Cragun* contains no suggestion of the above-cited limitations of claims 5 and 12.

Because *Cragun* fails to disclose each of the limitations of claims 5 and 12, it is respectfully submitted that these claims are patentable over the cited art under 35 U.S.C. §102(e).

V.   Rejection of Claims 1-4, 6-11, and 13-18 under 35 U.S.C. § 103(a)

Claims 1-4, 6-11, and 13-18 were rejected under 35 USC § 103(a) as being unpatentable over *Cragun* in view of *Nunberg*.

Because *Cragun* and *Nunberg*, either alone or in combination, fail to teach or suggest each of the limitations of claims 1-4, 6-11, and 13-18, it is respectfully submitted that these claims are patentable over the cited art.

Claims 1-4

It is respectfully submitted that the combination of *Cragun* and *Nunberg* fails to teach or suggest:

> receiv[ing], at the server machine, a request to perform a server action including at least one of an email operation, a chat operation, and a calendar operation; ... and
> perform[ing] said server action including incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation,

as recited in claims 1 and 4 (note: the bracketed 'ing' extensions appear only in claim 1).

As set forth with respect to claims 5 and 12, *Cragun* fails to teach or suggest either of the above-cited limitations found in claims 1 and 4. *Cragun* is exclusively directed to URLs and converting them "from an abbreviated form 220 to expanded form 230 to contain the full IP address and the places in the URL representing requests for information that should be sent with the URL." *Cragun*, col. 6, ll. 21-25. Nothing within *Cragun* suggests a modification of the mechanism disclosed therein to arrive at "receiv[ing] a request to perform a server action including at least one of <u>an email operation, a chat operation, and a calendar operation</u>," or "perform[ing] said server action including incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar

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operation," as recited in claims 1 and 4 (emphasis added). *Cragun's* sole teaching is to convert abbreviated URL's for document retrieval.

Nunberg similarly fails to teach or suggest the above-cited limitations. *Nunberg* is directed to "processing natural language text" and has only been cited for teaching "delimiters preceding and following substrings." *See Office Action*, p. 5; *Nunberg*, abstract. *Nunberg* contains no disclosure or suggestion relating to server actions such as "an email operation, a chat operation, and a calendar operation," as recited in claims 1 and 4.

Accordingly, it is respectfully submitted that even if *Cragun* and *Nunberg* are combined as suggested by the Examiner, the resulting combination fails to teach or suggest the above-cited limitations of claims 1 and 4. Neither reference addresses or suggests anything relating to "receiv[ing], at the server machine, a request to perform a server action including at least one of an email operation, a chat operation, and a calendar operation" or "perform[ing] said server action including incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation." The only suggestion of the combination of references is expanding URLs to identify "the location address (both the server name and the location within the server) of the document of interest," so that the document can retrieved. *Cragun*, col. 5, ll. 58-62.

Because the combination of references fails to teach or suggest each of the limitations of claims 1 and 4, it is respectfully submitted that these claims are patentable over the cited art. Claims 2-3 each ultimately depend from claim 1 and should be patentable for at least the reasons set forth above.

Claims 6-11

Claims 6-11 each ultimately depend from claim 5. As set forth above, *Cragun* fails to each or suggest each of the limitations of claim 5. Furthermore, as set forth with respect to claims 1-4, the combination of *Cragun* and *Nunberg* fails to teach or suggest each of the above – cited limitations of claim 5. Specifically, the combination fails to teach or suggest "receiving, at the server machine, a request to perform a server action including at least one of an email operation, a chat operation, and a calendar operation," and "performing said server action including incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation," as set forth above.

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Accordingly, for at least the same reasons as set forth with respect to claims 1-4 and 5, it is respectfully submitted that claims 6-11 are patentable over *Cragun* in view of *Nunberg* under 35 U.S.C. § 103(a).

Claims 13-18

Claims 13-18 each ultimately depend from claim 12. As set forth above, *Cragun* fails to each or suggest each of the limitations of claim 12. Furthermore, as set forth with respect to claims 1-4, the combination of *Cragun* and *Nunberg* fails to teach or suggest each of the limitations of claim 12. Specifically, the combination fails to teach or suggest "receiving, at the server machine, a request to perform a server action including at least one of an email operation, a chat operation, and a calendar operation," and "performing said server action including incorporating said expanded substring into display data associated with said at least one of an email operation, a chat operation, and a calendar operation," as set forth above. Accordingly, for at least the same reasons as set forth with respect to claims 1-4 and 12, it is respectfully submitted that claims 13-18 are patentable over *Cragun* in view of *Nunberg* under 35 U.S.C. § 103(a).

VI. Newly Added Claim

Claim 19 has been added and is believed patentable over the cited art. Claims 19 recites:

> said preceding and following word delimiters include all non-alphanumeric characters to indicate one of said abbreviated substrings.

As Applicants teach in the specification, the identification of abbreviations "has been successfully implemented by treating all non-alphanumeric characters as word delimiter characeters." *Specification*, p. 38, ll. 13-14.

Cragun does not teach or suggest this limitation. *Cragun* teaches that a "modal character (percent sign "%" in the preferred embodiment) indicates that the following information is abbreviated by tokens." *Cragun*, col. 6, ll. 7-9. Thus, *Cragun* does not teach or suggest "all non-alphanumeric characters to indicate one of said abbreviated substrings," as recited in claim 19. *Cragun* teaches the use of a modal character such as a "%" sign to indicate an abbreviation, not "all non-alphanumeric characters."

Likewise, *Nunberg* fails to teach or suggest the limitation of claim 19. *Nunberg* teaches a:

[d]ata sequence 130 includes delimiters indicating the textual types of textual type units in data sequence 132. The beginning of a textual type unit in data sequence 132 is indicated in data sequence 130 by its textual type, such as sentence (S), word (W), or comma-interpolation (CI). The ending of a textual type unit is similarly indicated by its textual type with an apostrophe, such as S', W' or CI'. *Nunberg*, col. 13, ll. 31-38.

Thus, *Nunberg* teaches the identification of a specific "textual type unit" by its "textual type," which in the provided examples are alphanumeric characters. *Nunberg* teaches individual indications of "textual types," using alpha-numeric characters that are specific to a textual type. *Nunberg* does not teach or suggest "preceding and following word delimiters [that] include all non-alphanumeric characters to indicate an abbreviated substring," as recited in claim 19 (emphasis added).

VI. Conclusion

Based on the above amendments and these remarks, reconsideration of claims 1-18 and consideration of newly added claim 19 is respectfully requested.
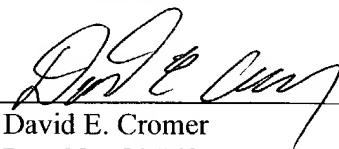
The Examiner's prompt attention to this matter is greatly appreciated. Should further questions remain, the Examiner is invited to contact the undersigned attorney by telephone..

Enclosed is a PETITION FOR EXTENSION OF TIME UNDER 37 C.F.R. § 1.136 for extending the time to respond up to and including today, May 17, 2004.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 501826 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: *May 17, 2004*   By: _____

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